

## **REMARKS**

### **I. Support for the Amendments**

Claims 7, 8, 11, 16, 19, 21, and 35 have been amended. In order to further prosecution in a timely manner, previously withdrawn non-elected claims 5, 33, and 34 have been cancelled without prejudice to their pursuit in an appropriate continuation or divisional application.

Support for amended claims 7, 8, 11, 16, 19, 21, and 35 can be found in the original specification and claims. Additional support for amended claims 7, 8, 11, 16, 19, 21, and 35 can be found, e.g., on pages 5-9; on page 6, lines 3-12; on page 16, lines 1-7; from page 16, line 18, to page 20, line 20; on page 17, lines 21-27; on page 18, lines 21-26; and in the Examples.

### **II. Status of the Claims**

Claims 1-34 were originally in the application, with claims 1, 5-8, 11, 16, 19, 21, 28, 33, and 34 being the independent claims. Claims 1-4 and 6-32 were elected with traverse in Response to the Election/Restriction Requirement, with claims 1, 7, 8, 11, 16, 19, 21, and 28 being the independent claims.

In the Office Action mailed 26 December 2002, the Examiner rejected claims 1-4 and 6-32, which were all the remaining claims. In the previous Amendment, filed June 20, 2003, claims 1, 6, and 28 were cancelled, and non-elected claims 5, 33, and 34 were

withdrawn without prejudice to the pursuit of such claims in a suitable continuing application.

Claims 2-4, 7-27, 29-32, and 35-43 were pending in the application, with claims 7, 8, 11, 16, 19, 21, 30, and 35 being the independent claims. In the Office Action mailed October 20, 2003, the Examiner rejected claims 2-4, 7-27, 29-32, and 35-43, all the remaining claims. In the Office Action mailed February 12, 2004 and in the present Office Action mailed July 13, 2004, the Examiner has also rejected claims 2-4, 7-27, and 35-43.

Claims 2-4, 7-27, and 35-43 are presently in the application. Claims 7, 8, 11, 16, 19, 21, and 35 are the independent claims and have been amended in the present Amendment. Claims 2-4 and 9-10 are now dependent on claim 7. Claims 12-15 are dependent on claim 11. Claims 17 and 18 are dependent on claim 16. Claim 20 is dependent on claim 19. Claims 22-27 are dependent on claim 21. Claims 36-43 are dependent on claim 35 or on claims dependent on claim 35. In order to further prosecution in a timely manner, previously withdrawn non-elected claims 5, 33, and 34 have been cancelled without prejudice to their pursuit in an appropriate continuation or divisional application.

### **III. Rejections under Staub Evidenced by Gibco BRL Products Catalog and Burgoyne are Withdrawn**

The Examiner has withdrawn the rejections under Staub et al. (U.S. Patent 6,187,540; February 13, 2001) as evidenced by Gibco BRL Products Catalog (FTA Card, page 2-7, 1999) and Burgoyne (US Pat. 5,496,562, March 1996).

Applicants thank the Examiner for withdrawing these rejections.

**IV. Rejection of Claims 2-4, 7-27, and 35-43 Under 35 U.S.C. § 112, Second Paragraph is Traversed, but Rendered Moot**

The Examiner has rejected claims 2-4, 7-27, and 35-43 under 35 U.S.C. §112, second paragraph (pp. 2-3; par. 5 (and 5A2)). The Patent Office alleges:

Claims 2-4, 7-27, 35-43 are indefinite over the recitation "comprises a dry solid medium" because it is unclear whether the second solid medium IS dry when it is contacted with the first solid medium or whether the second solid medium was at one point dry but also encompasses a medium which has been altered and is wet. The response appears to be arguing that the second solid medium is a dry solid medium when it is contacted with the first solid medium, however the claim is not clear either way. The rejection may be easily overcome by amending "contacting the cells on the first solid medium with a second solid medium wherein the second solid medium comprises a dry solid medium" to "contacting the cells on the first solid medium with a second solid medium wherein the second solid medium is a dry solid medium." (Pp. 2-3; par. 5 (subpar. 5A2).)

Applicants respectfully traverse this rejection, but have amended the claims in accordance with the Examiner's suggestion in order to further prosecution of the case.

Applicants respectfully submit that the cancellation of claims 2-4, 7-27, and 35-43 without prejudice renders moot the Examiner's rejection of these claims under 35 U.S.C. §112, second paragraph.

**V. Rejection of Claims 4 and 7 Under 35 U.S.C. §102(e) is Traversed, but Rendered Moot**

The Examiner has maintained the previous rejection of claims 4 and 7 under 35 U.S.C. §102(e) as being anticipated by Kathariou et al. (U.S. Patent 6,503,747; January 7, 2003) "as evidenced by [www-biology.ucsd.edu/labs/aroian/protocols/electroblot.htm](http://www-biology.ucsd.edu/labs/aroian/protocols/electroblot.htm) (pp. 5-6, par. 7). Applicants respectfully disagree.

The arguments of the Patent Office were discussed in the previous Amendment. In addition to reiterating these arguments, the Patent Office addresses the response in the previous Amendment and further alleges:

The response traverses the rejection. The response asserts that the claim has been amended to require that the second solid medium comprises a dry solid medium, such that the rejection has been overcome. The response argues that the membranes of Kathariou were wet with transfer buffer at the time of transfer and needed to be dried prior to processing (Response dated May 11, 2004, page 21). This argument has been reviewed but is not convincing because the claim limitation reads that the second solid medium comprises a dry solid medium. The claim does not require that the second solid medium IS dry when it is contacted with the first solid medium. The claim broadly encompasses a medium which was dry prior to apply the reagents, such that the second solid medium comprises a dry solid medium and liquid reagents. The examiner suggested claim language to applicant which would overcome the rejection of record, however, applicant indicated they would prefer an action in writing.

The response further asserts that it is not clear what "dissociating the cells of the biological sample" is referring to. With respect to Claim 4, the upstream processing of the biological sample includes the inoculation into wells, incubation, and dissociating the cells from the well plates to contact with the agar plates. The response appears as though they may be reading limitations into the claims which are not there. The claim states that the upstream processing step includes a dissociation of the cells of the biological sample. Kathariou teaches upstream processing which dissociates cells from the 96 well culture plates to place in suspension which is applied to the agar plates,

Thus for the reasons above and those already of record, the rejection is maintained. (Pp. 4-5; par. 6.)

Attorney Docket No.: 45858/56066

USSN 09/993,736

Filed November 14, 2001

Philpott et al.

Page 15 of 16

Applicants respectfully traverse this rejection, but have amended the claims in accordance with the Examiner's suggestion in order to further prosecution of the case.

Applicants respectfully submit that the present claims 4 and 7 fulfill the requirements of 35 U.S.C. §102(e) and request the Examiner's reconsideration of these claims accordingly.

## VI. Conclusion

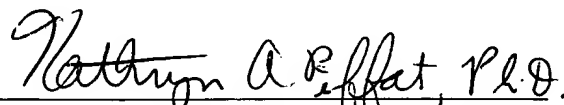
It is believed that all outstanding rejections have been addressed by this submission and that all the claims are in condition for allowance. If discussion of any amendment or remark made herein would advance this important case to allowance, the Examiner is invited to call the undersigned as soon as convenient.

In view of the foregoing amendments and remarks, the present application is respectfully considered in condition for allowance. An early reconsideration and notice of allowance are earnestly solicited.

Applicants believe that no extension of time is required. If, however, a petition for an additional extension of time is required, then the Examiner is requested to treat this as a conditional petition for an additional extension of time. Although it is not believed that any fee is required, in addition to the fee submitted herewith, to consider this submission, the Commissioner is hereby authorized to charge our deposit account no. 04-1105 should any fee be deemed necessary.

Respectfully submitted,

Date: October 13, 2004



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